



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,952	01/24/2001	Kazunobu Katoh	3709-0101P	2787

2292 7590 07/16/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 07/16/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,952

Applicant(s)

KATOH, KAZUNOBU

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 30, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The rejection in paragraph 1 set forth in the previous office action is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toya et al (Toya) in view of Murray and Suzuki.

Toya in column 17 lines 43-63 discloses a heat-developable photographic light-sensitive layer contains at least one light-sensitive layer on a support. The light-sensitive layer may be in a multiplayer form. In order to control the gradation, the light-sensitive layer may have high sensitivity layer/low sensitivity layer structure or low sensitivity layer/high sensitivity layer structure. The heat-developable light-sensitive material comprises reducible silver source, silver halide, reducing agent and binder. Thus, the material taught in Toya is substantially similar to that of the present claimed invention. The electron-transfer is taught in Murray in columns 9-10, compound IS-01 to IS-04; Suzuki in column 36, compounds (3) to (5).

The heat-developable imaging-recording material comprises two layer: a silver-supplying layer containing an organic silver salt, a reducing agent, an organic binder and "substantially no photosensitive silver halide", and a separate layer containing a photosensitive silver halide. The term "substantially no silver halide" in the silver-

Art Unit: 1752

supplying layer does not exclude any silver halide from the a silver-supplying layer and use of the language "containing" in the claimed language "a separate layer containing a photosensitive silver halide" does not exclude organic silver salt and other ingredient from that layer. Thus, imaging layers presented in the claimed invention has structure similar to that of multiplayer form taught in Toya in column 17, lines 55-60. Thus, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known electron-transfer taught in Murray or Suzuki to enhance the image contrast of a heat-developable material has mutilayer form taught in Toya to provide an invention and process as claimed.

4. Applicant's arguments filed April 30, 2002 have been fully considered but they are not persuasive.

It is the Examiner's position that the claimed invention would have been found prima facie obvious over the combination of the applied prior art of record. Toya in columns 21-22, example 1 may disclose a heat development material containing a single photosensitive layer containing silver halide, light-insensitive organic silver salt, reducing agent and binder, but suggest a multiplayer of photosensitive layer in column 17, lines 55-60. The worker of ordinary skill in the art would have from a heat developable material with multiplayer of light-sensitive layer containing high and low sensitivity of silver halide to provide an material similar to that of the claimed invention.

It was argue that Toya does not discloses or suggest removing silver halide from the aforementioned layer and place in a separate layer containing silver halide, and such modification would destroy the invention of Toya.

It is the Examiner's position that the language "substantially no photosensitive silver halide" does not mean that "no photosensitive silver halide" with the meaning "removing silver halide" provided in the applicants' argument. The invention presented in claim 16 or page 4 shows that the term "substantially no photosensitive silver halide" means that the amount of the halide used therein is 10 wt% or less. This amount is within the amount of silver halide taught in Example 1 of Toya. Note to the amount of substance used in the conversion of silver nitrate to silver halide such as "N-bromosuccinimide" which is 9.7 g. This amount is used to produce silver bromide and the silver nitrate of 365 g is used to produce organic silver salt and silver halide. Therefore, the amount of silver halide is relatively in small amount in comparison with to the coated amount. Accordingly, it is still believed that the claimed invention is still prima facie obvious over the combination of the applied prior art of record.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 1752


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
July 12, 2002


Thorl Chea
Primary Examiner
Art Unit 1752